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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,389	02/02/2000	Boris V. Marchegiani	11305/1	6138
26646	7590	07/17/2003		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			EXAMINER	
			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No.	Applicant(s)
	09/496,389	MARCHEGIANI, BORIS V.
	Examiner Ella Colbert	Art Unit 3624

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM

### THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed

- after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is extended, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 28 April 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1,4-6,8-11,15-17,19-24,26,28,29 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-6,8-11,15-17,19-24,26,28,29 and 35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Amendment***

1. Claims 1, 4-6, 8-11, 15-17, 19-24, 26, 28, 29, and 35 are pending. Claims 2, 3, 7, 12-14, 18, 25, 27, 30-34, and 36 have been cancelled and claims 1, 11, 17, 26, and 35 have been amended in this communication filed 04/28/03 entered as Amendment A with Extension of Time (3 months), paper no. 8.
2. Applicant's amendment to the Specification has been reviewed.
3. Applicant's cancellation of claims 7, 14, 18, and 27 have overcome the 112 second paragraph rejection to claims 7, 14, 18, and 27 and is hereby withdrawn.

### ***Specification***

4. The amended abstract of the disclosure is objected to for minor informalities because the Specification recites "A "tender" as defined herein, is the initial provision of an offer for a purchase or sale of commodity for use in an auction, ...". The Specification would be better read as "A "tender" as defined herein, is the initial provision of an offer for a purchase or sale of a commodity for use in an auction, ...". Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 4, 11, 17, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,285,383) Lindsey et al, hereafter Lindsey in view of (US 5,950,178) Borgato further in view of (US 5,168,446) Wiseman.

As per claims 1, 11, 17, 26, and 35, Lindsey teaches, a system for utilizing at least one tender, comprising:

a storage device storing data which relates to the at least one tender (col. 4, lines 5-12) and a processing device transmitting information corresponding to the data (col. 4, lines 33-46) and wherein the complex multi-variable commodity is a particular commodity whose price determination is based on a variation of a plurality of variable characteristics regarding a physical characteristic of the particular commodity (col. 23, lines 54-68, col. 24, lines 1-3, and fig. 2 (50- characteristic of the bale of cotton)).

Lindsey did not teach, wherein the at least one tender is provided for a complex multi-variable commodity, the processing device further enabling a user to request an exception to create or modify a term of the at least one tender. However, Lindsey does

implicitly teach, "the admit file 58 is written with data to note that a particular bale of cotton (commodity) was received at the warehouse, and the data indicating the date, time, and bale number, warehouse code and type of transaction (tender)" in col. 20, lines 3-9.

Wiseman discloses, a processing device transmitting information corresponding to the data, wherein the at least one tender is provided for a complex multi-variable commodity, the processing device further enabling a user to request an exception to create or modify a term of the at least one tender (col. 14, lines 21-39, col. 16, lines 27-54, fig. 8, fig. 11C, fig. 18A, and fig. 18B).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least one tender is provided for a complex multi-variable commodity, the processing device further enabling a user to request an exception to create or modify a term of the at least one tender and to modify in Lindsey's system because such a modification would allow Lindsey to have "the buyer invoiced for the amount of the sale plus any additional agreed upon costs (contract) (col. 23, lines 21-22) for the commodity (bales of cotton).

As per claim 11, A method for utilizing at least one tender, Lindsey did not teach, comprising the steps of receiving data for the at least one tender, the at least one tender being provided for a complex multi-variable commodity; and transmitting information corresponding to the data to a device.

Borgato discloses, receiving data for the at least one tender (col. 7, lines 29-33), the at least one tender being provided for a complex multi-variable commodity (col. 8,

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lines 1-12); and transmitting information corresponding to the data to a device (col. 8, lines 12-16).

As per claim 17, Lindsey also teaches, A system for utilizing at least one tender, comprising: wherein the at least one tender includes at least one of a term and a condition (col. 2, lines 47-50), and wherein the term and the condition are capable of being modified (col. 2, lines 51-67 and col. 3, lines 1-6).

As per independent claim 35 this independent claim reciting "A set of instructions residing in a storage medium, the set of instructions capable of being executed by a processor to implement a method for utilizing at least one tender" is rejected for the similar rationale as given for claim 11 because the method steps of claim 35 correspond to the method steps of claim 11. Claim 35 claims a set of instruction residing on a storage medium and claim 11 claims a method with corresponding steps.

As per claim 4, Lindsey teaches, the system according to claim 1, wherein the processing device executes a program on a remote device (col. 3, lines 59-65).

8. Claims 5, 6, 8-10, 15, 16, 19-24, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsey in view of (US 5,950,178) Borgato.

As per claims 5 and 20 The system according to claim 1, Lindsey did not teach, wherein the storage device includes a database storing data which is related to the at least one tender.

Borgato discloses, wherein the storage device includes a database storing data which is related to the at least one tender (col. 5, lines 25-49). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to have the storage device include a database storing data which is related to the at least one tender and to modify in Lindsey because such a modification would allow Lindsey to have a storage device that includes a database for various data relating to diamonds to be offered for sale as well as other data concerning those diamonds.

As per claims 6 and 21 The system according to claim 5, Lindsey and Borgato did not teach, wherein the database is a relational database, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the database to be a relational database and to modify in Lindsey and Borgato because such a modification would allow Lindsey and Borgato to store information in tables- rows and columns of data- and to conduct searches using data in the specified columns of one table to find additional data in another table which is old and well known in the database art.

As per claims 8 and 22, the system according to claim 1, Lindsey did not teach, wherein the processing device: receives the data, analyzes the data, and transmits the information to a further processing device, wherein the information is transmitted in response to the received data. Borgato discloses, wherein the processing device: receives the data (col. 9, lines 1-10), analyzes the data (col. 9, lines 43-65), and transmits the information to a further processing device (col. 10, lines 3-15), wherein the information is transmitted in response to the received data (col. 10, lines 66-67 and col. 11, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device: receive the data,

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analyze the data, and transmit the information to a further processing device, wherein the information is transmitted in response to the received data and to modify in Lindsey because such a modification would allow Lindsey to have a means for displaying the data to be analyzed according to weight class, shape subclass, cut sub-subclass, clarity, color corresponding to the array category and inputting the data by selecting a button 82 to transmit the data to the host processor.

As per claims 9, 15, 23, and 28, the system according to claim 1, Lindsey did not teach, wherein the processing device at least one of transmits and receives the information electronically via the Internet.

Borgato discloses, the processing device is at least one of transmits and receives the information electronically via the Internet (col. 7, lines 6-16 and lines 40-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a processing device to be at least one of transmits and receives the information electronically via the Internet and to modify in Lindsey because such a modification would allow Lindsey's system to run Microsoft web browser Internet Explorer or higher and to have the communication link established by making a telephone connection or satellite link to the host processor 12.

As per claims 10, 16, 24, and 29, the system according to claim 1, Lindsey did not teach, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices.

Borgato discloses, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices (col. 7,

lines 6-16 and lines 40-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device to be at least one of transmits and receives information electronically via a network of further processing devices and to modify in Lindsey because such a modification would allow Lindsey to have a processor that runs Microsoft web browser Internet Explorer and a dial-up networking and display setting for receiving and transmitting data.

As per claim 19, Lindsey teaches, wherein the processing device executes a program on a remote device (col. 3, lines 59-65).

***Response to Arguments***

9. Applicant's arguments filed 04/28/03 have been fully considered but they are not persuasive.

1. Applicant argues: The TELCOT system of Lindsey does not refer to, disclose or in any way suggest an exception to create or modify a term of the at least one tender has been considered but is not persuasive because Applicant appears to be arguing the amendment to claims 1, 17, and 26. Therefore, this argument is considered "moot."

2. Applicant argues: Borgato does not disclose or suggest the host processor enables a user to request an exception to create or modify the at least one tender as recited in claim 1 has been considered but is not persuasive because this argument is based on the amendment to claim 1 and addressed in argument number 1.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

May (US 6,421,653) disclosed trading financial instruments.

Bergato (WO 99/05629) disclosed transactions in diamonds and bidding.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Inquiries***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-746-5622 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
E. Colbert  
July 13, 2003

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600